

6/Ltr. re: Petition
Hawkins
1-21-03Docket No.: 2523-073

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Rikuro OBARA

Serial No. 10/087757

Filed: March 5, 2002

For: MOTOR

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: Group Art Unit: 2834

: Examiner: ELKASSABGI, HEBA

PETITION UNDER 37 CFR 1.181(A)(3)
TO INVOKE THE SUPERVISORY AUTHORITY OF THE COMMISSIONERAssistant Commissioner for Patents
Washington, D. C. 20231

Sir:

The Commissioner is petitioned hereby to invoke his supervisory authority and to direct consideration of applicant's paper, filed October 1, 2002, as a response to the Official Action of July 3, 2002, noting defects in the Action, in accordance with the provisions of MPEP §710.06.

STATEMENT OF THE FACTS INVOLVED

An Official Action was mailed in the above application on July 3, 2002. Upon consideration of the same, it was apparent that numerous defects exist in the Action and that such defects make it impossible to respond thereto.

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On October 1, 2002, undersigned attorney filed a paper entitled "Request for Corrected Action and Restarted Response Date" by facsimile, noting numerous errors in the Action.

Briefly summarizing the request, it was noted therein that the Action cited 6 of applicant's prior patents and (at paragraph 13) relied on one or more of those patents in rejecting claims 2, 8 and 9. However, both at paragraphs 9 and 13, the Action failed to identify which patent(s) was (were) being applied.

Applicant could not determine whether the rejection was based on one of the cited references or one of numerous other patents which he has obtained.

The Action further rejected (at paragraph 16) claims 3, 10 and 11 over art including a '291 reference (Miyazaki 5,547,291) and a specific one of applicant's prior patents ('209). In rejecting the claims the Action refers to a "column 8" in applicant's patent. However, the referenced prior patent of applicant does not have a "column 8".

Applicant could not determine whether how to respond, or indeed whether the rejection was based on another one of the cited references or on an unidentified one of numerous other patents which he has obtained.

The Action further rejected (paragraph 30) claims 5, 14 and 15 over the '291 reference and applicant's prior '209 patent, but failed to make any reference to the features of applicant's patent as supporting the rejection.

Applicant thus could not determine whether the rejections in fact did or did not rely upon applicant's prior patent, or whether the Action erroneously cited the same.

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Indeed, the Action also failed to cite the '291 reference in PTO Form 892 or to supply a copy of the same as is done in standard practice.

POINTS TO BE REVIEWED

It is believed that applicant's paper of October 1, 2002, may have been erroneously entered into the record as "Miscellaneous Correspondence" and that such identification has thus failed to generate a response as required by MPEP §710.06.

Applicant thus requests that such entry and identification be reviewed, and corrected, to reflect that applicant had timely filed a response to the Official Action on October 1, 2002. Applicant further requests review of failure of the Office to provide an appropriate response to that paper and that such a response be provided to applicant. In accordance with the provisions of MPEP §710.06, such a response from the Office should further set a new period for reply, being at least one month.

ARGUMENT

Prosecution in the Office should not be "piecemeal". Therefore, when an Action is incomplete and includes defects, MPEP §710.06 permits an applicant to receive a corrected Action, whether or not the period for response is fully restarted. With such a corrected Action, an applicant can provide a full (rather than piecemeal) response and can thus advance prosecution to Final Action.

In the present instance, in view of numerous defects in the Action, a full response on the merits of the application could not possibly have been provided. Applicant therefore provided a response to the defective Action which, upon proper action under MPEP

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§710.06, *should* have resulted in mailing of a complete Action to applicant. Applicant then could have responded to the Action in its entirety.

As no such corrected Action has been received, applicant still cannot respond to the entirety of the rejections. However, in an abundance of caution, and in view of the fact that six months have now passed since the mail date of the original Action, applicant feels constrained to file a paper addressing the merits of the Action, to the extent ascertainable from the Action.

Such a partial response is provided herewith, as a Supplemental Response and Amendment.

The response addresses the informality noted in the Action and addresses the merits of the rejection, to the extent based on a reference (Takemura et al. USP 5,880,545) applied to all the pending claims.

Because no response has been provided to applicant's earlier paper, and to assure continued pendency of the application, applicant provides herewith a *Provisional* Petition for Extension of Time, to be relied upon *if necessary* to maintain such pendency.

It is submitted that had applicant's earlier paper been properly entered as a response, the present Amendment would not be necessary to maintain pendency of the application. Moreover, if the earlier paper had been properly entered, the present paper would be entered as a Supplemental Response, and thus that neither a Petition for Extension of Time nor an Extension Fee would be necessary.

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It is therefore respectfully submitted that the actions taken by the Office:

- 1) improperly failed to recognize the proper nature of applicant's paper filed October 1, 2002; 2) improperly failed to designate the same as a response to the Official Action, and
- 3) improperly failed to provide a corrected Action in response thereto.

ACTION REQUESTED

It is accordingly requested that the Commissioner exercise his supervisory authority and direct proper designation of applicant's paper of October 1, 2002 as a timely response to the Action of July 3, 2002;

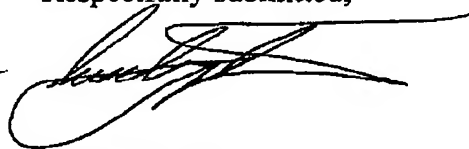
That the Commissioner further direct that a proper, non-final, response be provided thereto; and

That the Commissioner further direct that the paper accompanying the present Petition be entered as a Supplemental Amendment, without extension of time, and that a **FULL REFUND** be made of the Extension Fee provided herewith.

In view of the foregoing, and in view of Petitioner's conformity with the provisions of 37 CFR 1.181, favorable action on this Petition is in order and is courteously solicited. .

<p>CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, TC 2800, Fax no. (301) 872-9318 on the date shown below.</p> <p>January 3, 2003</p> <p>Israel Gopstein Registration No. 27,333</p>
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Respectfully submitted,



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